

Roanne De Menezes

Special Counsel



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Melbourne

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Overview

Roanne is a special counsel in Dentons' Intellectual Property group.

Roanne is a senior IP lawyer and registered trade marks attorney, with over 15 years of experience with a focus on trade marks and related rights.

Roanne manages multinational trade mark portfolios across a range of sectors, including fashion and luxury goods, food and beverage, chemicals, oils, building and construction, and biotech/life sciences.

Roanne has expertise in all aspects of trade mark management, from pre-filing clearance searches, to filing strategy advices, to filing and prosecution of trade marks locally and internationally. She also handles local and overseas contentious matters, including non-use and opposition proceedings.

Roanne frequently publishes articles on trade mark case law. She also regularly presents to businesses and to legal counsel groups, on trade mark law and practice.

Experience

- **Major Australian fashion group:** Representing local fashion group in managing trade mark portfolio nationally and internationally, including pre-filing advices and contentious matters, for each of the group's separate businesses.
- **Major sunglass company:** Representing owner of well-known sunglass brand in oppositions and appeals in first-to-file territory, to prevent third party squatter from securing rights in breach of client's mark.
- **International diagnostic device company:** Handling of all trade mark matters, including filing strategies.
- **Australian confectionery company:** Handling of Asian filing strategy, prosecution of marks in Asia, and trade mark portfolio management for Australia and Asia.

Insights

- "Revisiting the OEM exception to trade mark infringement in China," Dentons client alert, 14 October 2020
- "Innovating in the COVID-19 market," Dentons client alert, 9 June 2020
- "Extensions of time for IP applications in Australia," Dentons client alert, 7 April 2020
- "Think before you trade mark a wink: Registering emojis and emoticons," Dentons client alert, 14 February 2020
- "Trade marks and the rise of cryptocurrencies in the marketplace," Dentons client alert, 29 April 2019
- "Rise in medical cannabis trade marks in Australia," Dentons client alert, 25 February 2019
- "Adding GRANOLA to the mix? Reviewing the risks of genericism," *IAM Magazine*, September 2012
- "The Force of a Trade Mark – Lucasfilm takes action against third party application for 'Theforceawakens,'" *Lexology*, March 2018
- "A superstar brand: Opposition of SUPERSTAR application by adidas," *Lexology*, November 2017
- "Trade mark opposition: Implications of adopting a mark containing descriptive words of foreign origin," *Lexology*, January 2017
- "Trade Marks Office decision highlights benefits of searching for a trade mark before attempting to secure a registration," March 2016

Activities and Affiliations

Community Involvement and Pro Bono

Community Involvement

- Organising New Day Box's annual fundraiser

Pro Bono

- Roanne has conducted pro bono matters for:
 - 10x10 Philanthropy Limited
 - Karrke Pty Ltd
 - Poetry in Action
- Prosecutor for Butterfly Foundation's trade mark

Presentations

- Presenter, "Working with your marketing team to manage your company's brands", ACC, 2016-2017
- Speaker, "Marketing Matters" seminar on selecting, clearing and managing brands, ACLA (now ACC), 2014

Areas of focus

Practices

- Intellectual Property and Technology in Australia

- Intellectual Property and Technology

Education

- Monash University, 2001, Bachelor of Law, (First Class Honours)
- Monash University, 1998, Bachelor of Arts

Admissions and qualifications

- Trade Mark Attorney, 2006
- Supreme Court of Victoria, 2002